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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,872	05/26/2000	Jeffrey Steven Albrecht	00JSA001	9690

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EXAMINER

KAPADIA, MILAN S

ART UNIT PAPER NUMBER

3626

DATE MAILED: 02/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/579,872

Applicant(s)

ALBRECHT, JEFFREY STEVEN

Examiner

Milan S Kapadia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

*Notice to Applicant*

1. This communication is in response to the amendment filed 20 December 2002.

Claims 1-20 are pending.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (6,161,095) in view of Halvorson (4,847,764).

(A) Claims 1-3 and 5-7 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 5), and incorporated herein.

4. Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (6,161,095) and Halvorson (4,847,764) as applied to claim 1 above and further in view of Campbell (Campbell, Sandy, "Accordant meets the challenges that rare chronic diseases pose for managed care," Health Care Strategic Management, August 1996).

(A) Claim 4 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 5), and incorporated herein.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (6,161,095) and Halvorson (4,847,764) as applied to claim 6 above and further in view of Goetz et al. (6,421,650).

(A) Claims 8 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 5), and incorporated herein.

6. Claims 9-11 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (6,161,095) and Halvorson (4,847,764) as applied to claims 2 and 5 above and further in view of Rindfleisch (Rindfleisch, Thomas, "Privacy, information technology, and health care," Association for Computing Machinery, August 1997, volume 40, pages 92-100).

(A) Claims 9-11 and 16-17 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 5), and incorporated herein.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (6,161,095), Halvorson (4,847,764), and Rindfleisch (Rindfleisch, Thomas, "Privacy,

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information technology, and health care,” Association for Computing Machinery, August 1997, volume 40, pages 92-100) as applied to claims 6 and 11 above and further in view of Holliday (Holliday, Linda, “New media report card: Where are we now?” Medical Marketing and Media, February 1995, volume 30, pages 46-53).

(A) Claim 12 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 5), and incorporated herein.

8. Claims 13 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (6,161,095), Halvorson (4,847,764), and Rindfleisch (Rindfleisch, Thomas, “Privacy, information technology, and health care,” Association for Computing Machinery, August 1997, volume 40, pages 92-100) as applied to claims 8 and 9 above and further in view of Goetz et al. (6,421,650).

(A) Claims 13 and 14 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 5), and incorporated herein.

9. Claims 15, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (6,161,095), Halvorson (4,847,764), Rindfleisch (Rindfleisch, Thomas, “Privacy, information technology, and health care,” Association for Computing Machinery, August 1997, volume 40, pages 92-100), and Campbell (Campbell, Sandy, “Accordant meets the challenges that rare chronic diseases pose for managed care,”

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Health Care Strategic Management, August 1996) as applied to claims 4, 9, and 16 above.

(A) Claims 15 and 19-20 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 5), and incorporated herein.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (6,161,095), Halvorson (4,847,764), Rindfleisch (Rindfleisch, Thomas, "Privacy, information technology, and health care," Association for Computing Machinery, August 1997, volume 40, pages 92-100), and Goetz et al. (6,421,650) as applied to claims 13, 14, and 16 above.

(A) Claim 18 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 5), and incorporated herein.

### ***Response to Arguments***

11. Applicant's arguments filed 12/20/02 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed 12/20/02.

(A) At pages 2-3 of the 12/20/02 response, Applicant argues that "...the claimed

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'medication logging' function is not embodied by the scheduled reminders and patient feedback disclosed in Brown. The compliance monitor disclosed in Brown, therefore does not disclose a personal communication device that performs the function of 'medical logging'" in reference to claims 1-20. In response, it is noted that the features upon which applicant relies (i.e., logging the use of self-administered medications, which are taken in response to symptoms or as otherwise needed by the patient and assisting the patient in accurately recording the circumstances surrounding a patient's decision to use medication and the symptoms and circumstances that necessitated the usage ) are not recited in the rejected claim (s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 998 F.2d 1181, 26 USPQ2d 1057 (Fed Cir. 1993). Therefore, it is respectfully submitted, that the Examiner's interpretation of "medical logging" as presently claimed is not improper.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milan S Kapadia whose telephone number is 703-305-3887. The examiner can normally be reached on Monday through Thursday, 8:30 A.M. to 6:00 P.M. In addition the examiner can be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


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February 12, 2003

  
DINH X. NGUYEN  
PRIMARY EXAMINER